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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,993	01/16/2004	Toshiaki Noguchi	17371	8686
23389 7590 03/16/2009 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER NGUYEN, THUY-VI THI	
			ART UNIT 3689	PAPER NUMBER
			MAIL DATE 03/16/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/759,993

**Applicant(s)**

NOGUCHI ET AL.

**Examiner**

THUY VI NGUYEN

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-18, 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### DETAILED ACTION

1. This is in response to the applicant's communication filed on December 02, 2008, wherein:

Claims 7-18, 20 are currently pending;

Claims 1-6, 19 have been cancelled;

Claims 7-18, 20 have been amended;

As on 12/02/08, claim 7 (method) is amended as follow:

7. (Currently Amended) A medical equipment rental method comprising:

a rentee method having:

a) an examination category inputting step ~~of inputting-receiving an input of a~~  
category of ~~a-medical~~ an endoscopic examination on the basis of diagnosis results;

b) an examination date and time specifying step ~~of specifying an~~ receiving a..  
specified examination date and time for the ~~a-medical~~ endoscopic examination; and

c) a rental order generating step of generating an order for rental ~~of medical~~  
endoscope equipment required in the ~~medical-endoscopic~~ examination at the date and  
time specified in the examination date and time specifying step; and

a rental service method having:

d) ~~a-medical~~ an endoscope equipment securing step of managing securing of the  
~~medical-endoscope~~ equipment required in accordance with an the order generated in  
the rental order generating step;

e) a ~~medical-an endoscope~~ equipment dispatching step of managing dispatching ~~of the medical-endoscope~~ equipment secured in the equipment securing step, to the requesting hospital, at the date and time specified in the examination date and time specifying step; and

f) a reprocessing step of managing recovering the ~~medical-endoscope~~ equipment after rental has terminated and reprocessing the ~~medical-endoscope~~ equipment, wherein the reprocessing includes at least one of cleaning the endoscope equipment, and sterilizing the endoscope equipment.

### ***Claim Rejections - 35 USC § 101***

**2. 35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-18, 20 are rejected under 35 U.S.C. 101 because the claims deal with a system containing software and do not meet any of the statutory items such as process (method), machine (apparatus), manufacture (product) or composition. The system claims appear to be an apparatus claim in a preamble "*a medical equipment rental system comprising*", however, there are no normal structures or functional element which are required in an apparatus claim. For instant, the independent 13 recited "*input section, specifying section, order generating section, securing section, dispatching section, recovering section*" are appear to be software. The independent claims 19 and 20 recited "*input means for inputting, means for specifying, means for*

*generating, means for securing, means for dispatching, and means for recovering*" are also appear to be software. Therefore, the claims are directed to nonstatutory subject matter.

**Claims 7-12** are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must

- (1) be tied to another statutory class, (such as a particular apparatus), or
- (2) transform underlying subject matter (such as an article or materials).

Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to claims 7-12, the method claim is:

- (1) not tied to a particular machine or apparatus, nor
- (2) transforms a particular article to a different state or thing.

If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims **7-12**, the claim language does not transform the underlying subject matter and the process is not tied to another statutory class. The process steps of "*receiving an input of a category of an endoscopic examination ...; generating an order for rental endoscope equipment....; managing securing of the endoscope equipment .....*"

managing dispatching of the endoscope equipment.....; managing recovering endoscope equipment ... " is not tied to another statutory class even though "an endoscope equipment"/device is recited, it is not used to perform process steps as recited above. Therefore the claims are directed to nonstatutory subject matter.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7-18, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claim 13 recited "*input section , specifying section, order generating section, securing section, dispatching section, recovering section*" and all the " means" in claim is unclear. Therefore, it is interpreted as software having all the sections for inputting and generating information regarding to rental equipment.

As for independent claim 20, claim element "means for inputting ...., means for specifying...; means for generating....; means for securing....; means for dispatching....; means for recovering ...." is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Applicant's specification appears to disclose "means of communications lines (4), means of a rental service system (abstract) and figure 1; means of the hospital making detailed

specification (par. 0028); but not the means for plus function " as stated in claim above.

Therefore, applicant is required to

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. F& more information, see 37 CFR 1.75(d) aid MPEP 21si and 608.01(0).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAKAO et al (US 2003/0098022) in view of ROYER ET AL (US 2005/0187833) or vice versa and further in view of KIPPENHAN, JR. (US 2003/0012688)

**As for independent method claim 7**, NAKAO et al fairly discloses a similar medical equipment rental method comprising the steps of:

{see Fig. 1; par. 0054; 0055}

(a) receiving an input of medical examination/information /data based on the basis of diagnosis results;

{see par. [0006" ... *inputting the treatment records and various data of the patient*), par. [0014 ...*inputting data such as measurement result*], par. [0076 "...operation input section (302) and (703), figures 6-8, 15-19; disclose receiving data/message/information}

(b) specifying step of specifying an examination date and time for the medical examination [see par. 0113 and figure 14 "...*measurement/or examination date information*"; (see par. 0151 and figure 19 "...*date of using the medical*"); (par. 0152 and figure 20 "... *date of giving treatment*")]



c) generating step of generating an order for rental of medical equipment required in the medical examination;

{this is inherently included in the rental processing of NAKAO et al in order to obtain/rent the medical equipment. For example: *a renting processing section for performing processes related to renting of medical equipment* (par. 0079; figure 7 (element 507); *and receiving a request for renting a medical equipment and instruction for delivering medical equipment* (figure 22, Steps 401-403))}.

NAKAO et al discloses on pars. [0182] and [0185] that other medical equipment can be utilized. Therefore, the "endoscope equipment" also can be applied or utilized in the method of NAKAO ET AL.

NAKAO et al fairly teaches the claimed invention except for explicitly disclosing a rental service method having "managing securing the endoscope equipment required in accordance (step d); managing dispatching of endoscope equipment (step e); and reprocessing step of managing recovering the medical equipment after rental (step f)". Note that on pars. [0182] and [0185], NAKAO et al discloses that the renting process is not limited to the nebulizer or medical equipment alone, In other word, the renting process can be applied to other equipment as well and this is within the scope of the invention.

In a similar method for renting equipment, ROYER ET AL discloses well known steps for managing an equipment rental business including automated equipment rental management and reservation system comprising the steps of:

(d) securing equipment required/or acquiring equipment/or checking the equipment is available in accordance with an order [...i.e. *tracking the movement and status of the rental equipment; and confirm the availability of equipment for every reservation*; par. 0001; par. 0011-0012 and par. 0056 and figure 3 (*equipment available at cite* )];

(e) dispatching step of dispatching the equipment secured in the equipment securing step [...*dispatched the equipment form one place to another*; abstract; par. 0072; 0073 figure 5 (Dispatch 196)]; and

(f) a reprocessing step of recovering the equipment after rental has terminated/ or returned.

{see par. 0038 which teaches the recovering and updating of the returned equipment inventory after returning; par. 0063 and figure 4 (inventory list 114).

Note that on par. [0013]-[0014], ROYER ET AL discloses that the system updates automatically and regularly and provide the benefit that user will be able to view the status of each piece of equipment of a specified category at a particular location and determine whether any of the equipment is available for rental. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of NAKAO et al by including the well known equipment rental managing steps (d), (e) and (f) of ROYER ET AL cited above to obtain one of the benefit cited above.

Alternatively, the teachings of ROYER ET AL is cited above. ROYER ET AL fails to deal with equipment related to medical equipment and the steps for selecting the appropriate medical equipment such as steps (a)-(c) above. These steps are taught in

NAKAO et al above. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of ROYER ET AL by including the steps of identifying the medical equipment as taught by NAKAO et al as mere applying to other rental equipment as mentioned by NAKAO et al in par. [0182] and [0185].

NAKAO ET AL/ROYER ET AL disclose all the claim invention stated above except for the reprocessing the endoscope equipment which includes at least one of the cleaning the endoscope equipment, and sterilizing the endoscope equipment.

KIPPENHAN, JR. disclose the well known feature of reprocessing the endoscope equipment to remove bacterial biofilms within the long, narrow lumens of a flexible endoscope {abstract, pars 0001-0003, 0008-0009, 0020-0025; 0032} in order to provide an efficacy of a cleaning, disinfecting or sterilizing of instrument and medical equipment, e.g endoscope equipment. It would have been obvious to one of ordinary skill in the art to provide the method of NAKAO ET/ROYER ET AL to include the reprocessing the medical equipment by cleaning, disinfecting, or sterilizing the medical equipment device as taught by KIPPENHAN, JR in order to remove bacterial biofilm, and also provide the ability of the disinfectant to kill pathogenic under challenging conditions and related to the ability of AER's to deliver legally marketed disinfectants to the flexible endoscope being reprocessed. {KIPPENHAN, JR. pars. 0009, 0032}

**As for claim 8, Royer/Nakao discloses**

a reservation information generating step of generating reservation information including date and time information specified in the examination date and time

specifying step {see ROYER et al, par. [0007][...*specified date and type of equipment*],  
fig. 3]

**As for claim 9**, Royer/Nakao discloses wherein the medical equipment, e.g.  
endoscope equipment securing step comprises:

a reservation information receiving step receiving the reservation information  
generated in the reservation information generating step [figures 5 -6; par. 0072-0073];

a reservation judging step of judging whether or not the required endoscopic  
equipment can be secured at the date and time specified in the examination date and  
time specifying step { see ROYER et al. par. 0037 *reservation information can be  
changed to display* ; par. 0065 and figures 5-7 "*changes element* (140)} and

a reservation acceptance information generating step of generating information  
indicating that acceptance of the reservation information{ see ROYER et al. par. 0055;  
*"the status (46) can be changed to "YES" if the reservation for equipment are covered  
and scheduled complete"*}.

**As for claim 10**, Nakao/Royer discloses referring to an examination category  
correspondence table which associates categories of medical examination with types of  
medical equipment [See NAKAO figures 14 and 19 for the category of medical  
examination].

**As for claim 11**, Nakao/Royer discloses referring to an examination category  
correspondence table which associates categories of medical examination with types of  
medical equipment [See NAKAO figures 14 and 19 for the category of medical  
examination].

**As for claim 12**, Nakao/Royer referring to an examination category correspondence table which associates categories of medical examination with types of medical equipment [See NAKAO figures 14 and 19 for the category of medical examination].

As for **independent system claims 13 and 20**, which include the term "endoscope equipment" instead of "medical equipment" in the preamble and in the body of the claims, the term "endoscope" is merely the type or function of the medical equipment, this has no patentable weight in an apparatus claim since in apparatus claim, only structures matter and there is no structural differences. Moreover, NAKAO et al discloses on pars. [0182] and [0185] that other medical equipment can be utilized. More over, the system claims 13 and 20 which are different only from independent method claim 7 in the substitution of the "step for" for "means for", the system of NAKAO et al /ROYER ET AL includes the "mean for" for carrying out the "steps for" as indicated in Figs. 1-3. Alternatively, the substitution of "means for" for "steps for" would have been obvious as mere substitution of similar or equivalent terms. There fore, they are rejected for the same reasons set for the rejection of independent **claim 7 above**.

**As for claim 14**, Royer /Nakao disclose wherein the rental order generating section of the rentee system comprises:

a reservation information generating section for generating reservation information including the date and time information specified by the examination date and time specifying section and information about the medical equipment required in the medical examination [...see Royer; figures 5-6]; and

a reservation information transmission section for transmitting the reservation information generated by the reservation information generating section, to the rental service system [see Royer, figures 5-6 "dispatch 196"].

**Note:** claim 2 is directed toward a system which containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (1987).

**As for claim 14**, which has the same limitation as claim 9 above, it is rejected for the same reasons set forth in the rejection of claim 9 above.

**As for claims 16-18**, which deals with the types of examination category stored in a data base for identifying the types of medical equipment needed, i.e. use of a correspondent table, this appears to be taught in Figs. 14 and 19, wherein table format are used to identify the desired rental equipment, and Nakao; figures 1, 6, 7 and par. 0022, 0076, 0079 **for memory section** (304 and 505) which discloses an examination category correspondence storing section for storing an examination category correspondence table which associates categories of medical examination with types of medical equipment [see the medical equipment required in accordance with the order generated by the rental order generating section being secured by referring to this examination category correspondence table {this is inherently included in the rental processing of NAKAO et al in order to obtain/rent the medical equipment.

Moreover, these are merely data stored in a database and they appear to be non-functional descriptive material and have no patentable weight.

**Note:** claims 16-18 are directed toward a system which containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (1987).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 7-18, 20 have been fully considered but they are not persuasive.

As for an argument on 112, 2nd paragraph, Applicant states that the elements of the system claims 13 and 20 are supported by the specification, and the claims are not indefinite. The Examiner respectfully disagrees. Independent claim 13 appears to be an apparatus claim which must be recited structurally or functionally. However, all the elements input section, specifying section, order generating section, securing section, dispatching section, recovering section" and all the "means" for does not provide specific structure. It is vague and indefinite because these element can be read over as a software, not a physical section or area, or room as recited in the specification on page 4, line 8 to page 5, line 6 and figure 2. Therefore, the rejection under 112, 2nd paragraph is maintained.

For the reason stated above, the 35 U.S.C 101 rejection s maintained for claims 13 and 20 due to the system containing software per se and a further rejection on 35 U.S.C 101 is made for the method claim 7 due to the claim language does not transform

the underlying subject matter and the process is not tied to another statutory class as stated above.

As for an argument on page 10, Applicant states that ROYER does not teach a reprocessing step of managing recovering the endoscope equipment after rental has terminated and reprocessing the endoscope equipment includes at least one of cleaning the endoscope equipment, and sterilizing the endoscope equipment. The Examiner respectfully disagrees. The combination of ROYER /NAKAO disclose the step of management the rental equipment and managing the returning/recovering/receiving the equipment as showed on pars. 0038, 0063, 0074 figures 4, 5, 13 which disclose the inventory list which is updated of the returned equipment inventory after returning. As for the new limitation "wherein the reprocessing includes at least one of cleaning the endoscope equipment, and sterilizing the endoscope equipment", this is fairly taught in the combination of ROYER/NAKAO/KIPPENHAN JR as indicated above.

As for an argument on page 11, Applicant states that NAKAO does not expressly or inherently include generating an order for rental. The Examiner respectfully disagrees. NAKAO disclose on (par. 0079; figure 7) a renting processing section for performing processes related to renting of medical equipment and figure 22, pars. 0165-0173 wherein NAKAO disclose the receiving request information for renting a medical equipment also disclose the receiving a request for renting a medical equipment; and instruction for delivering the equipment when receiving the request for renting the equipment. Therefore, NAKAO inherently included the generating an order for rental the medical equipment.



As for an argument on page 12, Applicant states that NAKAO does not teach or suggest a correspondence table associating categories of endoscopic examination with types of endoscope equipment. The Examiner respectfully disagrees. This feature as recited in the dep. claims 16-18, which deals with the types of examination category stored in a data base for identifying the types of medical equipment needed, i.e. use of a correspondent table, this appears to be taught in NAKAO Figs. 14 and 19, wherein table format are used to identify the desired rental equipment, and Nakao; figures 1, 6, 7 and par. 0022, 0076, 0079 **for memory section** (304 and 505) which discloses an examination category correspondence storing section for storing an examination category correspondence table which associates categories of medical examination with types of medical equipment [see the medical equipment required in accordance with the order generated by the rental order generating section being secured by referring to this examination category correspondence table (this is inherently included in the rental processing of NAKAO et al in order to obtain/rent the medical equipment.

Moreover, these are merely data stored in a database and they appear to be non-functional descriptive material and have no patentable weight. As indicated in the rejection, these claims feature in dep. claims (16-18) are directed toward a system which containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (1987).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
3/12/09